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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,546	05/22/2000	Nathalie Jager Lezer	05725.0588-00000	1552

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EXAMINER	
TRAN, SUSAN T	
ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/576,546	LEZER, NATHALIE JAGER	
	Examiner	Art Unit	
	Susan T. Tran	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6 and 8-32* is/are pending in the application.

4a) Of the above claim(s) *8-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,6 and 14-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of applicant's Request for Continued Examination and Request for Extension of Time filed 11/03/04, Request for Extension of Time and Amendment filed 09/23/04.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/03/04 has been entered.

Election/Restrictions

Claims 8-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected specie, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/21/00.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 6, 14-24 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evison et al. WO 98/19652 in view of Arraudeau et al. US 4,659,562.

Evison teaches an anhydrous in the form of cosmetic, cleansing, or therapy from (see abstract). The composition comprises absorbent matrix including mixture of protein and hydrolyzed starch (pages 5-6); oils; surfactant; pharmaceutical active agent; cosmetic active agent, such as 1,3-butylenes glycol, panthenol, and pigments (pages 9-10); and toiletries active agent (page 10). The anhydrous cosmetic form can further comprises moisturizing agent, *e.g.*, butylenes glycol; waxes; powder, *e.g.*, cellulose, polymer, nylon, Teflon®, silk powder, or mixtures thereof (pages 14-15); and binder (page 19).

Evison does not specifically teach waxes, cellulose, polymer, nylon, Teflon®; silk powder, or mixtures thereof is in the form of fiber having the claimed length or diameter. However, no criticality is seen in the particular claimed limitation (L/D of fiber), because there are no unexpected and/or unusual results, which have been shown over Evison's invention. Applicant's attention is drawn to Evison at pages 11-12, where Evison recognizes the properties desired by applicant, *e.g.*, enhance effect, synergistically enhance topical delivery, homogeneous dispersion, new and more intense shades of color, lip glosses, gloss modifiers. Thus, it would have been obvious for one of ordinary skill in the art to, by routine experimentation optimize the anhydrous cosmetic

composition of Evison to obtain the claimed invention, because Evison teaches the use of similar materials for the same use, namely, anhydrous cosmetic composition.

Evison does not expressly teach the L/D of fiber, as well as the amount of fiber.

Arraudeau teaches the use of fiber having length much greater than diameter in an anhydrous cosmetic composition (column 1, lines 11-62). The fiber is used in an amount of from about 95% to about 5% (column 1, lines 37-42). Thus, it would have been obvious for one of ordinary skill in the art to modify the anhydrous cosmetic composition of Evison using the fiber having length much greater than diameter in view of the teaching of Arraudeau, because the references teach the advantageous result in the use of the similar materials in anhydrous cosmetic composition. The expected result would be an anhydrous make-up formulation that last long, and do not smear.

With regarding to the length and diameter of the fiber, it is the position of the examiner that it would have been obvious for one of the ordinary skill in this art to, by routine experimentation determine a suitable length and diameter of the fiber to obtain a desire anhydrous cosmetic formulation that will provide a long lasting appearance, and thus will not require repeated applications.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evison et al., in view of Bara et al. US 6,177,091.

Evison is relied upon for the reasons stated above. Evison does not teach parleam oil.

Bara teaches an anhydrous cosmetic composition comprising fiber, and oils, *e.g.*, parleam oil (columns 2-5). Thus, it would have been obvious for one of ordinary skill in

the art to use parleam oil of Bara for the anhydrous cosmetic composition of Evison. The reason for this modification is to obtain an anhydrous cosmetic composition that prevents unaesthetic folds, migration, and thus provides long lasting property on skin or lips. The expected result would be an anhydrous make-up formulation containing fiber useful for cosmetic fields.

Response to Arguments

Applicant's arguments filed 09/23/04 have been fully considered but they are not persuasive.

Applicant requests rejoinder of claims 8-13 based on the presumed allowability of claim 1. Applicant argues that the claims have been amended to incorporate the subject matter suggested by the Examiner in the previous Office Action dated November 05, 2003. Because the examiner has determined that these amendments would render the claims allowable, applicant submits that the claims as amended, are not obvious over Evison and are now in condition for allowance. In response to applicant's argument, due to new art rejections under Evison, the amended claims do not deem allowable. Accordingly, the original rejections by Evison are maintained. In response to applicant's request for rejoinder of claims 8-13, upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election,

applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Claims 1-3, 6, 14-24 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evison et al., in view of Arraudeau et al. US 4,659,562.

Applicant cited the Bausch & Lomb and Kotzab cases to allege that the examiner selectively chosen the presently claimed individual ingredients from isolated passages in Evison, without any motivation to choose, and then combine these ingredients. Contrary to the applicant's argument, applicant's attention is called to page 12, lines 27 through column 13, lines 1-2, where Evison teaches a specific lipstick formulation comprises besides the spray dried powder, one or more cosmetically acceptable additional ingredients suitable for lipstick, including gloss modifier, texture modifiers, and moisturizing agents. The moisturizer is defined at page 10, lines 1-3 as 1,3-butylene glycol. At page 15, lines 5-17, Evison specifically suggests a lipstick formulation, which comprises spray-dried powder and suitable non-pigment powders including micronized Teflon (PTFE) and silk powder. Again, at page 15, lines 23-24, Evison suggests lipstick further comprising a suitable pigment and moisturizer as active ingredients. Accordingly, Evison suggests mixture of the claimed ingredient in one specific formulation, namely, lipstick formulation. Thus, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it

takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that Evison does not recognize the advantages obtained by the claimed invention, specifically, the transfer resistance, applicant's attention is again called to page 12, lines 25-26 describes the lipsticks formulation taught by Evison reduces unsightly spread of color onto the skin adjacent to the lips (transfer resistance).

Applicant argues that Arraudeau does not teach fatty phase and at least one polyol. In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Arraudeau is relied upon solely for the teaching of fiber that can be used in cosmetic composition having the claimed length and diameter.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evison et al., in view of Bara et al. US 6,177,091.

Applicant argues that Bara does not teach fiber. In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Bara is relied upon solely for the teaching of parleam oil that can be used in cosmetic composition.

Pertinent Arts

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jager Lezer, Blin et al., Kanji, Collin, and Barber are cited as of interest for the teachings of dispersion of fiber with a fatty phase.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan T. Tran whose telephone number is (571) 272-0606. The examiner can normally be reached on M-R from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached at (571) 272-0602. The fax phone

number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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